

REMARKS

This paper is supplemental to our filing of January 25, 2010. In response to the Restriction Requirement mailed on October 12, 2010 from the United States Patent and Trademark Office, Applicants herewith file this Response to Restriction Requirement in which claims 12, 14, 15, 17, 20-23, 25, 26, 38, 40-42, 44, 47-50, 52-103 and 108-111 have been canceled (without prejudice or disclaimer), and claims 122-183 have been withdrawn (without prejudice or disclaimer). No new matter is added with this Response. Claims 112-121 are presented for examination.

The Office has identified eight patentably distinct inventions under 35 U.S.C. § 121 and required election of one of the following inventions for further prosecution:

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| Group I. | Claims 112-121, drawn to composition comprising demineralized bone matrix in a hydrogel carrier, classified in class 424, subclass 484. |
| Group II. | Claims 130-139, drawn to composition comprising demineralized bone matrix in a hydrogel carrier in which the demineralized bone matrix is about 20%, classified in class 424, subclass 484. |
| Group III. | Claims 148-157, drawn to composition comprising demineralized bone matrix in a hydrogel carrier in which the demineralized bone matrix is about 30%, classified in class 424, subclass 484. |
| Group IV. | Claims 166-175, drawn to composition comprising demineralized bone matrix in a hydrogel carrier in which the demineralized bone matrix is about 40%, classified in class 424, subclass 484. |
| Group V. | Claims 122-129, drawn to method of manufacturing a composition comprising mixing demineralized bone matrix in a hydrogel carrier, classified in class 424, subclass 484. |
| Group VI. | Claims 140-147, drawn to method of manufacturing a composition comprising mixing demineralized bone matrix in a hydrogel carrier in which the demineralized bone matrix is about 20%, classified in class 424, subclass 484. |
| Group VII. | Claims 158-165, drawn to method of manufacturing a composition comprising mixing demineralized bone matrix in a hydrogel carrier in which the demineralized bone matrix is about 30%, classified in class 424, subclass 484. |
| Group VIII. | Claims 176-183, drawn to method of manufacturing a composition comprising mixing demineralized bone matrix in a hydrogel carrier in which the demineralized bone matrix is about 40%, classified in class 424, subclass 484. |

As for Inventions V-VIII and I-IV, the Office contended that “Inventions V-VIII and I-IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product claimed can be made by materially different processes.”

As for the process Groups V-VIII, the Office contended that “Groups V-VIII are different in that the search for the generic Group V may not be the search for Group VI, or VII or VIII.”

As for the product Groups I-IV, the Office contended that “Groups I-IV are different the search for the generic composition Group I may not be the search for Groups II or III.”

The Office has identified the following patentably distinct species:

Compositions and methods in which the demineralized bone matrix is open, and others in which the demineralized bone matrix is at 20%, 30%, and 40% of the weight of the composition and the composition contains further additive that can modify physical and chemical aspect or biological aspect.

The Office has asserted that the species are independent or distinct because a chemical aspect is not a biological aspect. In addition, these species are not obvious variants of each other based on the current record.

In response, **Applicants hereby provisionally elect, with traverse, Group I (Species “compositions in which the demineralized bone matrix is open” for prosecution on the merits. Claims 112-121 read upon the elected species.** The Office has asserted that restriction for examination purposes as indicated is proper because all the inventions listed in the action are independent or distinct for the reasons given and there would be a serious search and/or examination burden if restriction were not required because “the inventions require a different search strategies or search queries.” Applicants respectfully disagree and submit that a search of all the claims does not constitute an undue burden on the Examiner as the Groups encompass the same class and similar subclasses. Therefore, reconsideration and withdrawal of the requirement for restriction are respectfully requested.

Applicants have withdrawn claims 130-139 (Group II), claims 148-157 (Group III), claims 166-175 (Group IV), claims 122-129 (Group V), claims 140-147 (Group VI), claims 158-

165 (Group VII) and claims 176-183 (Group VIII), as being directed to nonelected inventions, and reserves the right to file divisional applications during the pendency of this application directed to the nonelected subject matter.

The Office has required restriction between product and process claims. Since Applicants have elected claims directed to the product, should the product claims subsequently be found allowable, it is understood that withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claims will be considered for rejoinder, in which case the requirement for restriction between the product claims and the rejoined process claims will be withdrawn and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104.

Applicants submit that all claims are allowable as written and respectfully request early favorable action by the Examiner. If the Examiner believes that a telephone conversation with Applicants' attorney would expedite prosecution of this application, the Examiner is cordially invited to call the undersigned attorney of record.

The Commissioner for Patents is hereby authorized to charge the three-month extension of time fee, and any other fees associated with this filing, to Deposit Account No. 50-1561, Reference No. 019870.052201.

Respectfully submitted,
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Dated: February 11, 2011

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